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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/254,058	06/14/1999	CHEOL KIM	38724.66223	6431

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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 10/03/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/254,058

Applicant(s)

KIM, CHEOL

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003 and 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-15, 32, 33, 35 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-15, 32, 33, 35, and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

In response to the request for continued examination filed 08/11/03 and the amendment filed 07/09/2003, claims 6-15, 32, 33, 35 and 51 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/09/2003 has been entered.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. Claim 51 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis:

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply,

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involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claimed invention is within the technological arts.

Useful, Concrete and Tangible Analysis:

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the claimed invention fails to produce a concrete result. In order to produce a concrete result, the result must be guaranteed or there must be a reasonable expectation of success. The claimed result "whereby a viewer of the display learns a language" is neither guaranteed, nor reasonable expected. Although one viewer may be capable of learning through the method, there is no reasonable expectation that every viewer, or even a vast majority, will be capable of doing so.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed limitation "wherein the learning data is stored in an external memory that is selectively and releasable receivable by said communication interface" appears to be in contradiction to the claimed invention of independent claim 32, from which it depends. Claim 32 is clearly directed to downloading the language learning data from a network, the communication interface device must in this instance be a

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networking utility (i.e. an Ethernet card, modem, etc.). It is unclear how one is to connect the "external memory" to this device in a releasable receivable manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 6-15, 32, 33, 35 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stelovsky (US 5782692). Stelovsky teaches an input means for identifying selected pre-recorded language learning data which a user desires to obtain from an external network, said language learning data including audio data and caption (text) data, see col. 3: 5-8 and col. 23-26 (claims 6 and 32, and the means for identifying in claim 51); an interface means responsive to said input means for receiving the identified language learning data from the external network, said interface means in communication with the network, see col. 3: 24-26 (claim 6, the communication interface means of claim 32, and the means for receiving of claim 51); and a first memory means for storing the identified language learning data, see col. 2: 60 (claim 6, the internal memory of claim 32 and the means for recording of claim 51). A coder-decoder (CODEC) means for receiving the audio data component under the control of the controller means, said CODEC means converting the audio data component into analog audio signal and outputting

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the analog audio signals (claim 6, similar language in claim 32) is an inherent function of the sound card. A driver means for driving a display to display the caption data component under the control of the controller means is an inherent function of the video card (claim 6, 32, and means for selectively displaying in claim 51). See col. 3: 15-20 of Stelovsky. The controller output means outputs the caption data component and the audio data component synchronously to the display (claim 7 and similar language in claim 33) is taught at col. 8: 40-42. The means for playing said audio component (claim 51) is taught through the speakers and associated sound card, see col. 3: 10. Regarding claim 8, a mark number (time segment identification) indicating a subdivision of the caption data is shown at col. 2: 50-54 and a second memory means for storing an address of each caption data component is inherent to the memory systems of computers. Regarding claim 12, the ability to move forward or backwards through the learning data is at taught in Figures 13a, 13b and at col. 8: 52-55.

Stelovsky does not specifically mention the controller means for separating the identified language learning data into a caption data and an audio data component (claim 6), the digital signal processing/central processing unit (DSP/CPU) and means for separating the identified learning data into the caption data and audio data (claim 32) or means for subdividing the identified language learning data into an audio component and a caption component. It is within the common knowledge of those skilled in the art of computer architecture that different signals (i.e. audio, video) must be separated into individual components in order to be appropriately to being sent to their respective output device (video card for output to a display, sound card for output to speakers), this is a standard function of a CPU port system, main bus and video bus. As the aforementioned are inherent component within a computer; as such it would be obvious to one of ordinary skill in the art to include it in the Stelovsky invention and for it to perform these standard functions. Similarly, the functions of the DSP and microprocessor means, as in claims 9 and 10 are processes inherent to the microprocessor and CPU of a computer system. Regarding claim 11, an amplifier that amplifies the analog audio signals output through the CODEC means and that outputs the amplified analog audio signals to at least one of a speaker and an earphone is inherent to the functionality of a sound card and well known in the art. Further, this component is required for the sound card to be capable of producing an appreciable result. Regarding claim 13,

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Stelovsky does not specifically teach the operation of the microprocessor in the manner claimed.

However, it is well known in the art of computer architecture that a microprocessor may only deliver one type of information to the internal bus at any given moment. As such, when a microprocessor is transmitting multiple types of data (audio, video etc.) it must transmit alternate between logic states, where the logic state transmits and enable" signal to identify the current state and "turn on" the device intended for receipt of the information.

Stelovsky fails to specifically teach that the data is "learning data" yet mentions that the information can be used for "foreign language instruction". It is the examiner's position that this phrase refers to the same functional limitation. Further Stelovsky does not state that the network is the "Internet" (claim 51) or "Internet Based" (claim 6 and 32). But mention the use of a network, it is the examiner's position that the specific implementation of a network feature is a matter of design choice, and that such modifications are within the ordinary skill in the art. As such it would be obvious to one of ordinary skill in the art to implement the system of Stelovsky on an Internet or Internet-Based network so as to provide the service to a larger range of users. Further, with regards to claim 15, Stelovsky does not specifically teach the first memory means is a memory module that is removable from the language learning terminal. However, Stelovsky does teach removable mediums such as a CD-ROM. The ability to download and save information onto a removable medium is well known to those with common skill in the computer area, as such it would be obvious to incorporate the ability into the Stelovsky invention to make the information portable to the user. The examiner has interpreted the limitations of claim 35 to be substantially similar to those of claim 15, and as such the claim is rejected for the same reasons. Regarding claim 14, Stelovsky does not teach the use of Flash memory or a specific mention of RAM (Random Access Memory). The latter is a commonly known component of all computer systems and has been in common use since at least the introduction of the 8086 microprocessor. The former is a matter of design choice. Flash memory is known to be more mechanically stable than standard magnetic drives (typical hard-drives) but is generally more expensive. Supplementing a hard drive or other mass storage device with flash memory renders no clear advantage, nor does it have any significant disadvantages. Flash memory has a "block orientation", in that it must be written to in blocks of data. Typical hard-drives

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in computer systems function in the same manner. It would be obvious to one of ordinary skill in the art to incorporate a flash memory into the Stelovsky invention to create a more stable memory means.

Response to Arguments

5. Applicant's arguments with respect to claims 6-15, 32, 32, 35, and 51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Liu (US 5953005) teaches a system for downloading information from a network, the information including both textual and audio components

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Kathleen Christman



Teresa Walberg
Supervisory Patent Examiner
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